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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,796	11/13/2003	Diederik van Batenburg	2002-IP-007282 30545.56	4250

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Robert A. Kent
Halliburton Energy Service, Inc.
2600 S. 2nd Street
P.O. Box 1431
Duncan, OK 73536

EXAMINER

TUCKER, PHILIP C

ART UNIT	PAPER NUMBER
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1712

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/713,796

Applicant(s)

VAN BATENBURG ET AL.

Examiner

Philip C. Tucker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,6-12 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23 is/are allowed.
- 6) ☒ Claim(s) 1,2,6-12,17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1, 2, 6-12 and 17-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims teach inhibiting the hydration of the polymer using formate alone. Although the formate is taught in mixture with the polymer, such inhibiting by the formate alone is not taught in the specification as originally filed. In fact the specification at paragraph 0017 teaches that the formates do not have a negative effect on the hydration behavior of the polymers.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 6-9, 11, 12, 17-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briscoe (4336145) in view of Loftin (4536297).

Briscoe teaches a concentrate which comprises water, a hydratable polymer and an inhibitor for inhibiting the hydration of the polymer (see abstract). Briscoe teaches that the hydratable polymers may be guar derivatives as in the present claims (see column 3, lines 29-42). The use of a boron compound or sodium hydroxide as inhibitors, as in claims 6-8, is disclosed by Briscoe (column 3, line 61 column 4, line 8). The use of polymers such as hydroxyethyl cellulose as a viscosifier and thus suspending agents, as in claim 9 is taught (column 6, lines 57-63). Briscoe differs from the present invention in not teaching the use of a formate salt. Briscoe however teaches that when the concentrate is used to produce subterranean treating fluids, it preferably contains clay stabilizers, such as water soluble potassium salts (column 5, lines 27-34). Loftin teaches that various salts, including potassium formate may be used as clay stabilizers in well treatment fluids (column 3, lines 4-36). It would be obvious to one of ordinary skill in the art to use the clay stabilizing potassium formate of Loftin, in the fluid of Briscoe, given the teaching of Briscoe that water soluble clay stabilizing potassium salts are preferably used when the concentrate is used in well treatment.

3. Claims 1, 9, 10, 11, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Briscoe in view of Loftin as applied to claims 1, 6-9, 11, 12 and 17-20 above, and further in view of Dobson (5629271).

Briscoe in view of Loftin is taught above. Briscoe in view of Loftin differs in not teaching the use of welan as a suspending agent. Dobson teaches that welan and

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hydroxyethyl cellulose may be alternatively used as viscosifiers or suspending agents in well treating fluids (column 3, lines 17-29). It would thus be obvious to one of ordinary skill in the art to utilize the welan of Dobson for the hydroxyethyl cellulose disclosed by Briscoe, given the teaching of Dobson that such welan and hydroxyethyl cellulose may be alternatively used in well treatment fluids.

4. Claim 23 is allowable over the art of record. The prior art does not teach or suggest the use of the sodium formate in the current context of the claims.

Applicant's arguments have been considered but are not deemed persuasive. Applicant has argued that there is no motivation to modify or combine the references. All the references are in the art of well treatment, and teach at least one specific use as a completion fluid. Since all the references are in the same art area there is clear motivation to look at the teachings of the references, and combine such teachings given the clear suggestions therein. Loftin teaches that various salts, including potassium formate may be used as clay stabilizers in well treatment fluids (column 3, lines 4-36). It would be obvious to one of ordinary skill in the art to use the clay stabilizing potassium formate of Loftin, in the fluid of Briscoe, given the teaching of Briscoe that water soluble clay stabilizing potassium salts are preferably used when the concentrate is used in well treatment. Applicant argues that Loftin teaches away, since Briscoe teaches the use of potassium chloride, while Loftin teaches that there are problems associated with using potassium chloride. Such is not a teaching away, but such is a bolster for the use of

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potassium formate, instead of potassium formate, since Loftin teaches that potassium formate is superior to potassium chloride, in not having the corrosive properties of the potassium chloride. Such would thus be further motivation to one of ordinary skill in the art to use potassium formate in the composition of Briscoe.

There is a clear expectation of success that the potassium formate would act as a clay stabilizer in the composition of Briscoe, given the teaching of Loftin of the suitability for use in well treatment and completion compositions.

Although the prior art does not specify the use of the formate as a hydrate inhibitor, such does not warrant a reversal of obviousness. The courts have held that the "Assertion that examiner combined references for purpose different from that envisioned by applicant does not warrant reversal of examiner's finding of obviousness", (Ex parte Raychem Corp. 17 USPQ2d 1417). The courts have held that the mere difference in reason for adding one material to another is not patentable (In re Lintner 173 USPQ 560). The courts have also held that the discovery that a claimed composition possesses a property that is not disclosed in the prior art does not alone defeat a prima facie case of obviousness (In re Dillon 16 USPQ 1897). The totality of the case law is thus against the suggestion that the references fail to suggest all the claim limitations. The rejections are thus maintained.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C. Tucker whose telephone number is 571-272-1095. The examiner can normally be reached on Monday - Friday, Flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Philip C Tucker
Primary Examiner
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PCT-4139